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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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4-29-98

Applicants: Axel Friese et al.

Serial No.: 08/427,468

Art Unit: 3308

#51

Filed : April 24, 1995

Examiner: K. Reichle

For : TAMPON, ESPECIALLY FOR FEMININE HYGIENE, AND A  
PROCESS AND APPARATUS FOR PRODUCING THIS

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(Date)

Joel A. Rothfus

Name of applicant, assignee, or Registered Representative

  
(Signature)

April 20, 1998

(Date of Signature)

Assistant Commissioner for Patents  
Washington, D.C. 20231

APPEAL BRIEF

Dear Sir:

INTRODUCTION

This is an appeal from the Final Rejection dated October 15, 1997, rejecting Claims 9-12, 14-19, 23-26, and 28, i.e., all of the pending claims of Appellants' above-identified patent application.

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I. REAL PARTY IN INTEREST

The present pending application, Serial No. 08/427,468, is a continuation of Serial No. 08/124,374, which is a continuation of Serial No. 07/929,844, which is a continuation of Serial No. 07/799,922, which is a continuation of Serial No. 07/596,454. The assignment of Serial No. 07/596,454 has been sent to the Patent and Trademark Office on March 20, 1998 for recordation. Accordingly, the real party in interest in the present pending Patent Application is McNeil-PPC, Inc., a corporation of New Jersey, having an address at 199 Grandview Road, Skillman, New Jersey 08558.

II. RELATED APPEALS AND INTERFERENCES

There are no currently pending appeals or interferences relating to the present pending Patent Application.

III. STATUS OF THE CLAIMS

This appeal is taken from the Final Rejection of Claims 9-12, 14-19, and 23-26, i.e., all of the pending claims of the subject application (Claim 28 being canceled in the amendment filed herewith).

IV. STATUS OF THE AMENDMENTS

An amendment is being filed concurrently herewith. This amendment cancels Claim 28 and two of the amendments to the specification which have been objected to as adding new matter. In addition, the amendment conforms the specification to originally filed Claim 15. Appellants believe that the present pending claims stand as provided in the appended Exhibit A.

V. SUMMARY OF THE INVENTION

The presently claimed invention is directed to a tampon for feminine hygiene. The tampon comprises a generally cylindrical absorbent portion having a generally cylindrical compressed, solid fiber core from which longitudinal ribs extend radially outward. Each of the ribs (1) has a proximal end attached to the fiber core, (2) is compressed less than the fiber core, thereby having a coarser capillary structure than the fiber core, and (3) is separated from adjacent ribs at the proximal end by an amount greater than such rib is separated from an adjacent longitudinal rib proximate the distal end. In a preferred embodiment (Claim 25), adjacent ribs are in contact adjacent their distal ends.

The presently claimed invention also relates to an apparatus for producing a tampon from an approximately cylindrical tampon blank. The apparatus comprises first and second groups of press dies, at least three press dies in each group. The press dies are arranged in a plane perpendicular to the longitudinal press axis, and they are adapted to move radially inward toward the longitudinal press axis into a closed position. The inward motion can press the tampon blank into a tampon preform. The first group of press dies has side flanks so that when the first group of press dies are in the closed position their side flanks form guide surfaces for each of the second group of press dies. In addition, each of the press dies has an end face, and the end faces collectively form a generally cylindrical surface having a diameter when the press dies are in the closed position. Also, each of the press dies has a press cutter having a distal end projecting from its end face toward the longitudinal press axis to form a groove in the tampon preform, leaving ribs extending outward from the longitudinal press axis between adjacent grooves. The distal ends of the press cutters are extended to an essentially equal radial distance from the longitudinal press axis in forming the tampon preform. A second part of the

apparatus has a stationary conical forming die arranged coaxially relative to the longitudinal press axis. This die is capable of softening the distal ends of the ribs. The forming die has an entry orifice having a diameter that approximately corresponds to the diameter of the generally cylindrical surface formed by the end faces of the press dies in the closed position, and a smaller exit orifice.

VI. ISSUES

- A. Whether the Declaration filed on or about February 7, 1991 is acceptable, i.e. whether the non-initialed alterations in the residence and citizenship of the second inventor renders the Declaration invalid.
- B. Whether the amendments to the Specification filed on August 22, 1994, and April 14, 1997, impermissibly introduce new matter under 35 USC §132.
- C. Whether the Specification conveys that the inventors had possession of the subject matter of presently pending Claims 9-12, 14-19, and 23-26 at the time the application was filed as required by 35 USC §112, first paragraph.
- D. Whether the Specification enables the subject matter of Claims 9-12, 14-19, and 23-26 as required by 35 USC §112, first paragraph.

VII. GROUPING OF THE CLAIMS

Claims 9 and 23 are independent claims, Claims 10-12 and 14-19 being dependent, *inter alia*, from Claim 9, and Claims 24-26 and 28

being dependent from, *inter alia*, Claim 23. The Office has conceded that all of these claims distinguish over the prior art.

For the purposes of the formal matters in the rejection, Appellants will refer to the following groupings: Independent Claim 9 and dependent Claims 10-12 and 14-19 relate to an apparatus for producing a tampon, and they stand together. Independent Claim 23 and dependent Claims 24-26 relate to a tampon, and they stand together.

## VI. ARGUMENTS

### A. OBJECTION TO THE DECLARATION

The Office (referring to Paper No. 28) objects to the originally filed declaration due to the presence of non-initialed alterations allegedly contained therein. The Office does not allege that the statements pertaining to the veracity of the declared statements or the duties of the inventors of the declaration has been altered. The alleged alterations identified in Paper No. 28 relate to the residence of one inventor and the citizenship of the other. These are factual matters, and they do not affect the veracity of the declared statements of the inventorship or duties of the inventors. For these reasons, Appellants respectfully submit that the declaration should be accepted. Further, a substantially contemporary document, the executed assignment, corroborates the residence and citizenship of the inventors disclosed in the declaration. For these reasons, Appellants respectfully request that the objection to the declaration be withdrawn.

B. OBJECTION TO THE AMENDMENTS TO THE SPECIFICATION FILED ON AUGUST 22, 1994, AND APRIL 14, 1997 UNDER 35 USC §132

The Office objects to three amendments to the specification filed on or about August 19, 1997, and April 8, 1997, as introducing new matter. Appellants have requested above that two of these three be canceled in the accompanying amendment. Appellants respectfully submit that the third objection, to page 3, lines 20-21, lacks foundation. The specification at page 7, lines 26-29, clearly indicates that the longitudinal ribs touch. Thus, the grooves formed between adjacent ribs are closed as described in the amended Brief Description of the Drawing. Withdrawal of this objection is solicited.

C. REJECTION OF CLAIMS 9-12, 14-19, AND 23-26 UNDER 35 USC §112, FIRST PARAGRAPH (POSSESSION OF THE CLAIMED INVENTION)

The Office refers to the new matter rejection and indicates that the interpretation of the claims (e.g. the meaning of "tampon") is affected by the alleged new matter. Therefore, it argues that the invention encompassed by the claims was not clearly conveyed to those skilled in the art at the time the application was filed.

The test for compliance with the description requirement, whether the inventor had possession of the claimed subject matter, is factual. It involves a determination whether a person skilled in the art would reasonably conclude from the disclosure that the inventor had possession of the later claimed invention as of the filing date. How the disclosure accomplishes this fact is unimportant. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ 2d 1111, 1116 (Fed. Cir. 1991).

As pointed out in Section B, above, two of the alleged new matter additions have been canceled. The remaining addition is

fully supported in the original specification. Therefore, the facts of the present case support the determination that the inventors had possession of the presently claimed invention as of the original filing date. This is certainly the case for the apparatus claims which do not rely on the definition of the term "tampon" in any substantial way. This is also true of the product claims, because the terms in the claims are consistent with the originally filed disclosure. Therefore, Appellants respectfully request that this rejection be withdrawn.

D. REJECTION OF CLAIMS 9-12, 14-19, AND 23-26 UNDER 35 USC §112, FIRST PARAGRAPH (ENABLEMENT)

The Office alleges that Figs. 2 and 4 are inconsistent - Fig. 2 shows outwardly open grooves and Fig. 4 shows outwardly closed grooves. Paper No. 28 (referred to in this objection) concludes that the specification fails to adequately teach how to make/use the invention, because it is allegedly unclear whether the tampon, as made, includes open or closed grooves.

Appellants respectfully point out that the independent claims do not require open or closed grooves, merely that "each of the ribs is separated from adjacent ribs at the proximal end by an amount greater than such rib is separated from an adjacent longitudinal rib proximate the distal end" (Claim 23). This relationship is disclosed in both Figs. 2 and 4. Therefore, this claim is enabled. Further, Claim 25 requires that "each of the longitudinal ribs contacts an adjacent longitudinal rib at a point adjacent its distal end". This is specifically enabled at page 7, lines 24-29.

The question of enablement is whether "the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention" MPEP 2164.01, citing various court decisions. The above paragraph points to specific

support for two examples of the product claims. This support sufficiently enables the present claims.

Further, in its broadest scope, the claimed tampon may have the following embodiments: outwardly open, outwardly closed, or both open and closed grooves. The alleged inconsistency between Figs. 2 and 4 can be recognized by the skilled practitioner as an issue of detail in Fig. 4 and a corresponding lack of detail in Fig. 2. This lack of detail in Fig. 2 does not rise to a level of inadequate teaching of the invention. In any event, this matter relates to the tampon claims, not the apparatus claims. The apparatus claims relate to an apparatus for manufacturing a tampon. This is sufficiently enabled and defined. Therefore, the apparatus claims are formally acceptable, independent of the tampon claims.

In addition, the Office objects to the specification for allegedly failing to provide antecedent basis for the subject matter of Claim 15. Appellants have amended the specification to import the claimed range from the originally filed claim 15 into the specification at page 8, line 29. For these reasons, Appellants respectfully request that these rejections be withdrawn.

Respectfully submitted,



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April 20, 1998

Exhibit A

CURRENTLY PENDING CLAIMS

9. An apparatus for producing a tampon from an approximately cylindrical tampon blank, comprising: (i) first and second groups of press dies, at least three press dies in each group, the press dies arranged in a plane perpendicular to a longitudinal press axis and adapted to move radially inward toward the longitudinal press axis into a closed position so as to press the tampon blank into a tampon preform, the first group of press dies having side flanks so that when the first group of press dies are in the closed position their side flanks form guide surfaces for each of the second group of press dies, each of the press dies having an end face, the end faces collectively forming a generally cylindrical surface having a diameter when the press dies are in the closed position, each of the press dies having a press cutter having a distal end projecting from its end face toward the longitudinal press axis, the distal ends of the press cutters are extended to an essentially equal radial distance from the longitudinal press axis in forming the tampon preform, each of the press cutters adapted to form a groove in the tampon preform, leaving ribs extending outward from the longitudinal press axis between adjacent grooves, the ribs each having a distal end; and (ii) a stationary conical forming die arranged coaxially relative to the longitudinal press axis for softening the distal ends of the ribs, the forming die having an entry orifice having a diameter that approximately corresponds to the diameter of the generally cylindrical surface formed by the end faces of the press dies in the closed position, and a smaller exit orifice.

10. Apparatus according to Claim 9, wherein each press cutter projects radially inward from the press die end face by an equal distance and is separated from its respective adjacent press cutter by an equal angular amount ( $\alpha$ ).

11. Apparatus according to Claim 10, wherein the end face of each of the press dies has the same shape.

12. Apparatus according to claim 11, wherein each press cutter has a longitudinally extending curved face.

14. Apparatus according to Claim 9, wherein the length of each of the press cutters in the longitudinal direction and the width of each of the press cutters in the radial direction are about 10 and 2 mm respectively.

15. Apparatus according to Claim 14, wherein when the press dies are in the closed position, the distal ends of the press cutters are disposed 2 to 4 mm from the longitudinal axis.

16. Apparatus according to claim 9, wherein the entry orifice has a diameter of 20 mm and the exit orifice has a diameter of 13 mm.

17. Apparatus according to Claim 16, wherein the approximately cylindrical tampon blank has a diameter and all the press dies are adapted to move radially inward to approximately the diameter of the tampon blank, the press dies of the first group being adapted to move further radially inward into the closed position before the press dies of the second group move further radially inward.

18. Apparatus according to Claim 16, wherein all of the press dies are adapted to simultaneously move radially inward into the closed position.

19. Apparatus according to Claim 18, further comprising (i) an input end adapted to receive the blank, and (ii) a ram arranged on the input end, the ram being axially movable for pushing the preform through the conical forming die.

23. A tampon for feminine hygiene, comprising a generally cylindrical absorbent portion having a generally cylindrical compressed, solid fibre core from which longitudinal ribs extend radially outward, wherein each of the ribs has a proximal end attached to the fibre core, each of the ribs is compressed less than the fiber core, thereby having a coarser capillary structure than the fibre core, each of the ribs is separated from adjacent ribs at the proximal end by an amount greater than such rib is separated from an adjacent longitudinal rib proximate the distal end.

24. The tampon of Claim 23, wherein the absorbent portion comprises a needled nonwoven material.

25. The tampon of Claim 23, wherein each of the longitudinal ribs contacts an adjacent longitudinal rib at a point adjacent its distal end.

26. The tampon of Claim 23, wherein the compressed fiber core has a diameter of 4 to 8 mm.